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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,290	12/28/2001	Roman D. Halko	20002.0227	2669
23517	7590	10/19/2005	EXAMINER	
SWIDLER BERLIN LLP 3000 K STREET, NW BOX 1P WASHINGTON, DC 20007			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/028,290	Applicant(s) HALKO ET AL.	
	Examiner Alvin A. Hunter	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-30, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18, 22-28 and 34 is/are allowed.
- 6) ☒ Claim(s) 1-12, 16, 20, 21, 29, 30 and 34 is/are rejected.
- 7) ☒ Claim(s) 13-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 20, 21, 29, 30, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 20, 29, and 35 both recite the limitation "another synthetic rubber" in the following lines of the most current changes made of the claims by the applicant.

Claim 1: line 14;

Claim 20: line 7;

Claim 29: line 14; and

Claim 35: line 14.

The limitation is indefinite because it encompasses more than what is disclosed in regards to synthetic resins.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (USPN 5713801).

In regards to claims 32 and 33, Aoyama discloses multi-layer, wound golf ball comprising a center **115**, an intermediate layer **120**, a wound layer **125** of a tensioned material disposed over the intermediate layer and having a thickness less than 1mm, and a cover disposed over the wound layer wherein the tensioned material is glass or carbon (See Figure 2, Column 2, lines 49 through 60: and Column 3, lines 11 through 15 and lines 39 through 46). Aoyama discloses the same structure as that claimed by the applicant; therefore, it is submitted that the compression and COR values are inherent therein. But if in doubt, one having ordinary skill in the art would be aware that the compression value and the COR value is of typical values within the art. One having ordinary skill in the art would have found it obvious to have a golf ball with such compression and COR values because it is common within the art to have such values for golf balls.

Claims 4-6, 9-12, 16, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (USPN) in view of Rajagopalan (USPN 6001930).

In regards to claim 4, Aoyama discloses multi-layer, wound golf ball comprising a center **115**, an intermediate layer **120**, a wound layer **125** of a tensioned material disposed over the intermediate layer having a thickness less than 1mm and having the tensioned material is glass, polyamide, or carbon, and a cover disposed over the wound layer and made of a thermosetting material, in particular balata, which is trans-polyisoprene (See Figure 2, Column 3, lines 11 through 15, lines 39 through 46 and

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lines 49 through 60; and Column 3, lines 19 through 22). Aoyama does not disclose the intermediate layer having a Shore D hardness. Rajagopalan discloses the Shore D hardness of the intermediate layer being 20 to 75 (See Column 21, lines 4 through 14). One having ordinary skill in the art would have found it obvious to have a Shore D hardness of the intermediate layer of Aoyama being 30 to 85, as taught by Rajagopalan, in order to improve the distance, durability and feel of the golf ball.

In regards to claim 5, Aoyama discloses the center **115** comprised of polybutadiene (See Column 3, lines 34 through 38).

In regards to claims 6, 9, and 10, the center has a diameter from about 1.2 to 1.6 cm being that the outside diameter is 1.4 to 1.8 inches and the thickness of the wound layer is 0.01 to 0.10 inches (See Column 3, lines 11 through 15).

In regards to claims 11 and 12, Aoyama discloses the cover made of ionomer, but does not disclose the intermediate layer made of a thermoset material. Rajagopalan discloses a golf ball having an intermediate layer having a thermoset material, in particular a sulfonated thermoset polymer, and a cover having a thermoplastic material, in particular polyolefin ionomer (See Column 5, lines 39 through 57, and Column 6, lines 37 through 43). One having ordinary skill in the art would have found it obvious to have the intermediate layer and cover of Aoyama made of a thermoset and thermoplastic material, as taught by Rajagopalan, in order to improve the distance, durability and feel of the golf ball.

In regards to claim 16, Aoyama, in Figure 2, shows the cover 130 being a single layer.

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In regards to claim 29, Aoyama discloses multi-layer, wound golf ball comprising a fluid filled center **115**, an intermediate layer **120**, a wound layer **125** of a tensioned material disposed over the intermediate layer and having the tensioned material is a fiber, and a cover disposed over the wound layer and made of a thermosetting material, in particular balata, which is trans-polyisoprene (See Figure 2, Column 3, lines 11 through 15, lines 39 through 46, and lines 49 through 60., Column 3, lines 19 through 22 and 34 through 38). Aoyama does not disclose the intermediate layer having a Shore D hardness. Rajagopalan discloses the Shore D hardness of the intermediate layer being 20 to 75 (See Column 21, lines 4 through 14). One having ordinary skill in the art would have found it obvious to have a Shore D hardness of the intermediate layer of Aoyama being 30 to 85, as taught by Rajagopalan, in order to improve the distance, durability and feel of the golf ball.

Allowable Subject Matter

Claims 17, 18, 22-28, and 34 are allowed.

Claims 13-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 1 12, 2nd paragraph, set forth in this Office action.

Claims 2, 3, 20, 21, and 30 may be allowable if rewritten to overcome the Rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 6/07/05 have been fully considered but they are not persuasive. Applicant argues the following issues:

a) in regards to 35 USC 112, 2nd paragraph rejection that the limitation "another synthetic rubber" is definite and one skilled in the art would know what is meant in light of the limitation and specification.

b) In regards to rejection under 35 USC 103 that no motivation is present and accusations of hindsight.

The examiner disagrees.

With regards to issue a), the examiner disagrees that one skilled in the art would know what is encompassed by the limitation "another synthetic resin". The language is actually "another synthetic rubber" in which was a typographic error. The language is so broad that it reads in synthetic rubbers that have yet to be invented. How would one skilled in the art know what "another synthetic rubber" encompasses if the synthetic rubbers has not yet been invented. The limitation clearly read beyond the scope of the specification and what the applicant regards as the invention.

With regards to issue b) the examiner disagrees that hindsight was used in order to construct the rejection and there was suggestion of motivation. It should be pointed out that the applicant does not point out any supposed deficiencies as to why no motivation is suggested. BE that the applicant does not point out any supposed deficiencies, argues with respect to motivation are moot. In reference to hindsight, Aoyama shows the golf ball as claimed by the applicant but does not discloses the

COR. Being the Aoyama meets the structure as claimed by the applicant it is presumed that Aoyama meets the COR requirements claimed by the applicant; therefore, rendering the rejection not on the basis of hindsight. If applicant disagrees with the reasoning, it is requested that applicant show that Aoyama does not inherently meet the COR limitation; therefore, burden has been shifted to the applicant.

It should also be noted that rejections regarding claims 13-15 have been removed in light that the combination does not provide motivation for the cover to be a thermoset material. For all of the above reasons, the above action has been furnished.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-

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4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.



EUGENE KIM
PRIMARY EXAMINER